

## **REMARKS**

### **I. Introduction**

Claims 12 to 25 are pending in the present application. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

### **II. Rejection of Claims 21 and 23 Under 35 U.S.C. § 112, First Paragraph**

Claims 21 and 23 were rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement. Applicants respectfully disagree with the present rejection for at least the following reasons.

As an initial matter, the Office bears the initial burden of presenting "evidence or reasons why persons skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims." (See M.P.E.P. § 2163.04 (citing In re Wertheim, 541 F.2d 257, 262, 265, 191 U.S.P.Q. 90, 96, 98 (C.C.P.A. 1976))) (emphasis added). The M.P.E.P. also provides that if an examiner rejects a claim based on the lack of a written description, the examiner should "identify the claim limitation not described" and provide "reasons why persons skilled in the art would not recognize the description of this limitation in the disclosure of the application." (See id.). However, the written description requirement is not an in haec verba requirement. That is, "the specification 'need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the [filing] date the applicant had invented what is now claimed.'" All Dental Prodx LLC v. Advantage Dental Products Inc., 64 U.S.P.Q.2d 1945, 1948 (Fed. Cir. 2002) (quoting Eiselstein v. Frank, 52 F.3d 1035, 1038, 34 U.S.P.Q.2d 1467, 1470 (Fed. Cir. 1995)). Moreover, a "failure of the specification to specifically mention a limitation that later appears in the claims is not a fatal one when one skilled in the art would recognize upon reading the specification that the new language reflects what the specification shows has been invented." All Dental Prodx, 64 U.S.P.Q.2d at 1948 (citing Eiselstein, 52 F.3d at 1039, 34 U.S.P.Q.2d at 1470). An applicant can show "possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention." M.P.E.P. § 2163 (citing Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41 U.S.P.Q.2d 1961, 1966 (Fed. Cir. 1997)).

The application as filed sufficiently describes the subject matter included in claims 23 to 25. As such, these claims are supported by an adequate written description.

In view of the foregoing, withdrawal of this rejection is respectfully requested.

**III. Rejection of Claims 12 to 15, 18 to 20, 22, 24, and 25 Under 35 U.S.C. § 103(a)**

Claims 12 to 15, 18 to 20, 22, 24, and 25 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 4,965,833 ("McGregor et al.") and U.S. Patent No. 3,755,625 ("Maston"). It is respectfully submitted that the combination of McGregor et al. and Maston does not render unpatentable the present claims for at least the following reasons.

As an initial matter, it is noted that U.S. Patent No. 4,449,238 ("Lee et al.") is mentioned on the last line of page 3 of the Office Action. It appears that mention of Lee et al. is a typographic error. Clarification is nevertheless respectfully requested.

The proposed combination of McGregor et al. and Maston does not disclose, or even suggest, all of the features recited in claims 12 to 15, 18 to 20, 22, 24 and 25. Claim 12, for example, relates to a communications device for transmitting acoustic signals in a motor vehicle, which includes a control unit that is assigned at least one control element configured to weight signal levels of at least one transmitter device.

Nothing in either McGregor et al. or Maston discloses, or even suggests, a control unit that is assigned at least one control element configured to weight signal levels of at least one transmitter device. The Office Action admits that this feature is not suggested by McGregor et al. Neither is it disclosed or suggested by Maston. Rather, Maston describes only a selection of one microphone with a disconnection of all others. In contrast, claim 12 provides for a control element to weight signal levels of a transmitter device. This arrangement may allow multiple signals to be transmitted at the same time, with each signal properly weighted based on the configuration of the control element of each transmitter device, as described in paragraph [0005] of the specification. Since Maston does not disclose, or even suggest, weighting signal levels of a transmitter device, Maston also does not

disclose, or even suggest, a control element configured to weight signal levels of a transmitter device.

As explained above, the proposed combination of McGregor et al. and Maston does not disclose, or even suggest, all of the features of claim 12. Therefore, it is respectfully submitted that the combination of McGregor et al. and Maston does not render unpatentable claim 12.

As for claims 13 to 15, 18 to 20 and 24, which depend from claim 12, it is respectfully submitted that the combination of McGregor et al. and Maston does not render unpatentable these dependent claims for at least the reasons more fully set forth above.

Claim 22 also relates to a communications device for transmitting acoustic signals in a motor vehicle and includes a controlling means assigned at least one control element means for weighting signal levels of at least one transmitting means. Therefore, for at least the reasons given above in relation to claim 12, the proposed combination of McGregor et al. and Maston does not disclose, or even suggest, all of the features of claim 22. It is therefore respectfully submitted that the combination does not render unpatentable claim 22.

As for claim 25 which depends from claim 22, it is respectfully submitted that the combination of McGregor et al. and Maston does not render unpatentable this dependent claim for at least the reasons more fully set forth above.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

#### **IV. Rejection of Claim 17 Under 35 U.S.C. § 103(a)**

Claim 17 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of McGregor et al., Maston and PCT International Patent Application Publication No. WO 99/049698 ("Schaaf"). It is respectfully submitted that the combination of McGregor et al., Maston and Schaaf does not render unpatentable the present claims for at least the following reasons.

As explained above the proposed combination of McGregor et al. and Maston does not disclose, or even suggest, all of the features of claim 12, from which claim 17 depends. Schaaf does not cure the critical deficiencies more fully set forth above with respect to the combination of McGregor et al. and Maston. Thus, it

is respectfully submitted that the combination of McGregor et al., Maston and Schaaf does not render unpatentable claim 17, which depends from claim 12.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

**V. Rejection of Claim 16 Under 35 U.S.C. § 103(a)**

Claim 16 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of McGregor et al., Maston and Lee et al. It is respectfully submitted that the combination of McGregor et al., Maston and Lee et al. does not render unpatentable the present claims for at least the following reasons.

As explained above the proposed combination of McGregor et al. and Maston does not disclose, or even suggest, all of the features of claim 12, from which claim 16 depends. Lee et al. do not cure the critical deficiencies more fully set forth above with respect to the combination of McGregor et al. and Maston. Thus, it is respectfully submitted that the combination of McGregor et al., Maston and Lee et al. does not render unpatentable claim 16, which depends from claim 12.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

**VI. Rejection of Claims 21 and 23 Under 35 U.S.C. § 103(a)**

Claims 21 and 23 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of McGregor et al., Maston and Japanese Patent Publication No. 4,449,238 ("Yoshioka"). It is respectfully submitted that the combination of McGregor et al., Maston and Yoshioka does not render unpatentable the present claims for at least the following reasons.

As explained above the proposed combination of McGregor et al. and Maston does not disclose, or even suggest, all of the features of claim 12, from which claims 21 and 23 depend. Yoshioka does not cure the critical deficiencies more fully set forth above with respect to the combination of McGregor et al. and Maston. Thus, it is respectfully submitted that the combination of McGregor et al., Maston and Yoshioka does not render unpatentable claims 21 and 23, which depend from claim 12.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

**VII. Conclusion**

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

Date: January 15, 2008

By: /Clifford A. Ulrich/  
Clifford A. Ulrich  
Reg. No. 42,194

KENYON & KENYON LLP  
One Broadway  
New York, New York 10004  
(212) 425-7200  
**CUSTOMER NO. 26646**